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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,333	01/31/2001	James A. Eldridge	CPTI.70554	4267
758	7590	02/28/2005	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/773,333

Applicant(s)

ELDRIDGE ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 31 January 2001. Claims 1-17 are pending.

### ***Claim Objections***

2. Claims 11-12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 11 recites "[a] computer-readable medium having computer-executable instructions for performing the steps recited in claim 1." However, claim 1 is a method claim. It is unclear whether Applicant is further limiting the method, or whether applicant seeks protection for the medium alone. Claim 12 recites "[a] computer system having a memory, an operating system and a central processor, said processor being operable to execute the instructions stored on the computer-readable medium of claim 11." However, claim 11 is drawn to a computer-readable medium; it is unclear how a computer system further limits a "computer-readable medium." These claims do not pass the "Infringement Test" for dependent claims. See MPEP § 608.01 (n).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 3 recites "said acknowledgement form from" on line 4. There is insufficient antecedent basis for this limitation. For the purpose of applying art, Examiner assumes the word "form" to be a typographical error and that the limitation should read "said acknowledgment from."

(B) Claims 4-8 incorporate the features of independent claims 1 and 2 through dependency and are also rejected.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 7, 9-12, 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Provost et al., U.S. Patent Number 6, 341, 265.

(A) As per claim 1, Provost teaches a method in a computer system for submitting insurance reports (Provost; Abstract), the method comprising:

creating, with a client computer, a claim file containing at least one insurance report, said report being formatted in one of a set of known standard formats (Provost; column 8, lines 21-31);

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transmitting said claim file to a different site (reads on jurisdiction) over a computer network connection (Provost; column 8; lines 59-62); and

receiving a response (reads on an acknowledgement) from said jurisdiction over said computer network connection (Provost; column 9, lines 6-13).

(B) As per claims 2-4, 7, Provost teaches a method as analyzed and discussed in claim 1 above wherein said transmitting step comprises:

sending said claim file to a transmitter database (Provost; column 9, line 65 to column 10, line 22); and

sending said claim file from said transmitter database to said different site (reads on jurisdiction) when said jurisdiction is connected with said transmitter database (Provost; column 8 line 59 to column 9, line 6);

wherein said receiving step comprises:

receiving, by said transmitter database, said response (reads on acknowledgement) from said different site (reads on jurisdiction) for each report (Provost; column 9, lines 6-13, column 9, line 65 to column 10, line 22) ; and

sending, to said client computer, said response (reads on acknowledgement) from said transmitter database (Provost; column 8 line 59 to column 9, line 6);

wherein said insurance report within said claim file is an insurance claim (Provost; column 9, line 59 to column 10, line 22); and

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further comprising performing, by said transmitter database, edits upon said response (reads on acknowledgement) prior to sending said response (reads on acknowledgement) from said transmitter database (Provost; column 9, line 65 to column 10, line 62).

(C) As per claims 9-12, Provost teaches a method as analyzed and discussed in claim 1 above

wherein said creating step comprises:

accessing a transmitter/reporter database (Provost; column 7, line 40 to column 8, line 14);

receiving, from said transmitter/reporter database, prompts for information (Provost; column 4, lines 21-29); and

inputting, with said client computer, information as prompted by said transmitter/reporter database (Provost; column 4, lines 21-37),

wherein said client computer interacts with said transmitter/reporter database to create a claim file that is formatted in one of a set of known standard formats (Provost; column 8, lines 21-31);

wherein the network is the Internet (Provost; Figure 1, column 7, lines 60-62);

further including a computer-readable medium having computer-executable instructions for performing the steps recited in claim 1 (Provost; column 6, lines 29-31); and

further including a computer system having a memory, an operating system and a central processor, said processor being operable to execute the instructions stored on the computer-readable medium of claim 11 (Provost; column 6, lines 29-45).

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(D) Claims 13-15 differ from method claims 1-3 by reciting a "computer readable medium having computer-executable components" in the preamble. As per this limitation, Provost clearly discloses his invention to be implemented on a "computer readable medium having computer-executable components" (Provost; column 6, lines 29-45). The remainder of claims 13-15 repeats the limitations of claims 1-3, and is therefore rejected for the same reasons given above for claims 1-3.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-6, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost et al., U.S. Patent Number 6, 341, 265 as applied to claims 1-3 above, and further in view of Miller, U.S. Patent Number 5, 235, 702.

(A) As per claim 5, Provost teaches a method as analyzed and discussed in claims 1-3 above.

Provost fails to explicitly disclose further comprising performing, by said transmitter database, structural edits on said claim file prior to sending said claim file to said jurisdiction.

However, the above features are well-known in the art, as evidenced by Miller.

In particular, Miller teaches

performing, by said transmitter database, structural edits on said claim file prior to sending said claim file to said jurisdiction (Miller; Figure 5, Item 98, column 7, lines 21-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Provost to include performing, by said transmitter database, structural edits on said claim file prior to sending said claim file to said jurisdiction, as taught by Miller, with the motivations of providing a system for the automated processing of medical insurance claims that is based on the use of software that automatically interprets and corrects for imperfections and abnormalities, verifies suspect configurations, and posts the received, scanned, and converted claims directly to the providing medical computer system (Miller; column 2, line 64 to column 3, line 5).

(B) As per claim 6, Provost and Miller teach a method as analyzed and discussed in claims 1-3 and 5 above

further comprising performing, by said transmitter database, field-level edits on said claim file prior to sending said claim file to said jurisdiction (Miller; column 8, lines 4-14).

(C) Claims 16-17 differ from method claims 5-6 by reciting a "computer readable medium having computer-executable components." As per this limitation, Provost clearly discloses his invention to be implemented on a "computer readable medium having computer-executable components" (Provost; column 6, lines 29-45). The remainder of claims 16-17 repeats the limitations of claims 5-6, and is therefore rejected for the same reasons given above for claims 5-6.



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The motivations for combining the respective teachings of Provost and Miller are as given in the rejection of claim 5 above, and incorporated herein.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Provost et al., U.S. Patent Number 6, 341, 265 as applied to claims 1-3 above, and further in view of Peterson et al., U.S. Patent Number 6, 343, 271.

(A) As per claim 8, Provost teaches a method as analyzed and discussed in claims 1-3 above.

Provost fails to explicitly disclose a method further comprising tracking a status of said report through said transmitting and receiving steps.

However, the above features are well-known in the art, as evidenced by Peterson.

In particular, Peterson teaches a method further comprising tracking a status of said report through said transmitting and receiving steps (Peterson; Abstract, column 4, line 66 to column 5, line 20, column 7, lines 5-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Provost to include further comprising tracking a status of said report through said transmitting and receiving steps, as taught by Peterson, with the motivations of providing a claims processing system that would more easily allow health care providers to easily learn of the status of submitted insurance claims, thereby reducing the uncertainty as to whether a claim to be submitted is likely to be paid or rejected (Peterson; column 3, lines 54-63).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Maxwell, United States Patent Number 6, 098, 070, Underwood et al., United States Patent Number 5, 873, 066, Iliff, United States Patent Number 6, 022, 315, Burks, et al., United States Patent 5, 664, 778, and McKee et al., United States Patent Number 6, 272, 482 teach the environment of online tracking of insurance claims.

11. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington D.C. 20231**

or faxed to: **(703) 305-7687.**

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."  
Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. It should be noted that during the month of April 2005, the examiner's phone number will change

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to (571) 272-6774, however the current phone number will remain in service until the change takes place. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.


13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. It should be noted that during the month of April 2005, Joseph Thomas' phone number will change to (571) 272-6776, however the current phone number will remain in service until the change takes place. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*NP*

Natalie A. Pass

February 22, 2005

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
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